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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,811	08/10/2005	Andreas Fink	10191/3705	1654
26646 7590 12/18/2007 KENYON & KENYON LLP ONE BROADWAY NEW YORK, NY 10004			EXAMINER MITCHELL, KATHERINE W	
			ART UNIT 3677	PAPER NUMBER
			MAIL DATE 12/18/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/524,811

Applicant(s)

FINK ET AL.

Examiner

Katherine W. Mitchell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-11 and 13-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-11 and 13-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The information disclosure statement filed 2/18/2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Note that the Notice of DO/EO acceptance mailed 9/28/2005 lists only the following as received:

*The following items have been received:*

- *Copy of the International Application filed on 02/18/2005*
- *English Translation of the IA filed on 02/18/2005*
- *Copy of the International Search Report filed on 02/18/2005*
- *Copy of IPE Report filed on 02/18/2005*
- *Preliminary Amendments filed on 02/18/2005*
- *Information Disclosure Statements filed on 02/18/2005*
- *Oath or Declaration filed on 08/10/2005*
- *Request for Immediate Examination filed on 02/18/2005*
- *U.S. Basic National Fees filed on 02/18/2005*
- *Substitute Specification filed on 02/18/2005*
- *Priority Documents filed on 02/18/2005*

**1893.03(g) Information Disclosure Statement  
in a National Stage Application**

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**[R-3]**

.....

When all the requirements for a national stage application have been completed, applicant is notified (Form PCT/DO/EO/903) of the acceptance of the application under 35 U.S.C. 371, including an itemized list of the items received. The itemized list includes an indication of whether a copy of the international search report and copies of the references cited therein are present in the national stage file. The examiner will consider the documents cited in the international search report, without any further action by applicant under 37 CFR 1.97 and 1.98, when both the international search report and copies of the documents are indicated to be present in the national stage file. The examiner will note the consideration in the first Office action. There is no requirement that the examiners list the documents on a PTO-892 form. See form paragraphs 6.53, 6.54, and 6.55 (reproduced in MPEP § 609.03<). Otherwise, applicant must follow the procedure set forth in 37 CFR 1.97 and 1.98 in order to ensure that the examiner considers the documents cited in the international search report.

This practice applies only to documents cited in the international search report relative to a national stage application filed under 35 U.S.C. 371. It does not apply to documents cited in an international preliminary examination report that are not cited in the search report. It does not apply to applications filed under 35 U.S.C. 111(a) claiming the benefit of an international application filing date.

Applicant states that courtesy copies of the missing documents were provided with the response mailed 10/29/2007. No such copies were received, thus again the documents are not considered. The omission is no longer considered inadvertent.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claim 18 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The added material which is not supported by the original disclosure is as follows: the surface of the head to which the shank is attached includes tothing to prevent unscrewing. The only support for any tothing that examiner can find is at the bottom of Column 2, in paragraph [0027]:

[0027] Furthermore, it is possible to provide a star-shaped tothing at head 2, which represents an additional guard

, which is completely silent

on which head surface has the tothing – it is described as provided at the head, not even necessarily on the head. As written, the tothing must be on the surface to which the shank is attached, which is underside of “36” in reference, or underside of “2” of applicant.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-11,13-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites “the surface of the head that is opposite the shank is smooth”. A surface opposite is generally taken to mean facing, absent some definition. Examiner also notes that “the surface of the head” lacks antecedent basis. Noting a quote from

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applicant's arguments on 10/29/2007: " *Claim 9, as presented, provides that at least the surface opposite the shank is smooth, and further provides...*" so it is clear that applicant is intending to describe the surface as opposite the shank, not the head.

Examiner does not really consider "opposite" to be a good description, but since it is used, the only surface that she can even broadly consider "opposite the shank" is the facing surface of the head—ie, the planar surface of 36, which is directly across from the shank.

#### Definitions of **opposite** on the Web:

- being directly across from each other; facing; "And I on the opposite shore will be, ready to ride and spread the alarm"- Longfellow; "we lived on ...
- face-to-face: directly facing each other; "the two photographs lay face-to-face on the table"; "lived all their lives in houses face-to-face across the street"; "they sat opposite at the table"  
[wordnet.princeton.edu/perl/webwn](http://wordnet.princeton.edu/perl/webwn)

Claims 10,11, and 13-18 are rejected as depending from rejected claim 9.

5. Claim 14 recites the limitation "the thread" in line 3. There is insufficient antecedent basis for this limitation in the claim, as there are threads disclosed in both the bushing and on the bolt.

#### ***Drawings***

6. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the toothing included on the surface of the head to which the shank is attached must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate

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prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

7. The amendment filed 10/29/2007 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: the surface of the head to which the shank is attached includes tothing to prevent unscrewing. The only support for any tothing that examiner can find is at the bottom of Column 2, in

[0027] Furthermore, it is possible to provide a star-shaped tothing at head 2, which represents an additional guard paragraph [0027]: , which is completely silent on which head surface has the tothing – it is described as provided at the head, not even necessarily on the head. . As written, the tothing must be on the

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surface to which the shank is attached, which is underside of "36" in reference, or underside of "2" of applicant.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 9-11,13-14, and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Jacob et al USP 6309132

Jakob teaches a fastening comprising

A first component with a threaded bushing (housing 10 with threaded inserts 16,18, Column 2 lines 52-65)

a 2<sup>nd</sup> component (column 40) with a keyhole-like cut out with a smaller 50,52 and larger opening 46,48 (42,44, see Column 2 line 64-Column 3 line 6)

a self-locking (Column 3 lines 18-23, copied below) bolt 20 configured to be screwed into bushing such that it is guided with the head (24,36 is considered the head) through the larger opening (Fig 2) and head engages behind the smaller cut out, said bolt having tool engagement surfaces 32 at an end of the shank 28, and the head is round and has a smooth surface (at least 36 is round and has a smooth surface). Note that "36" is considered part of the head, and "36" is clearly the surface of the head that



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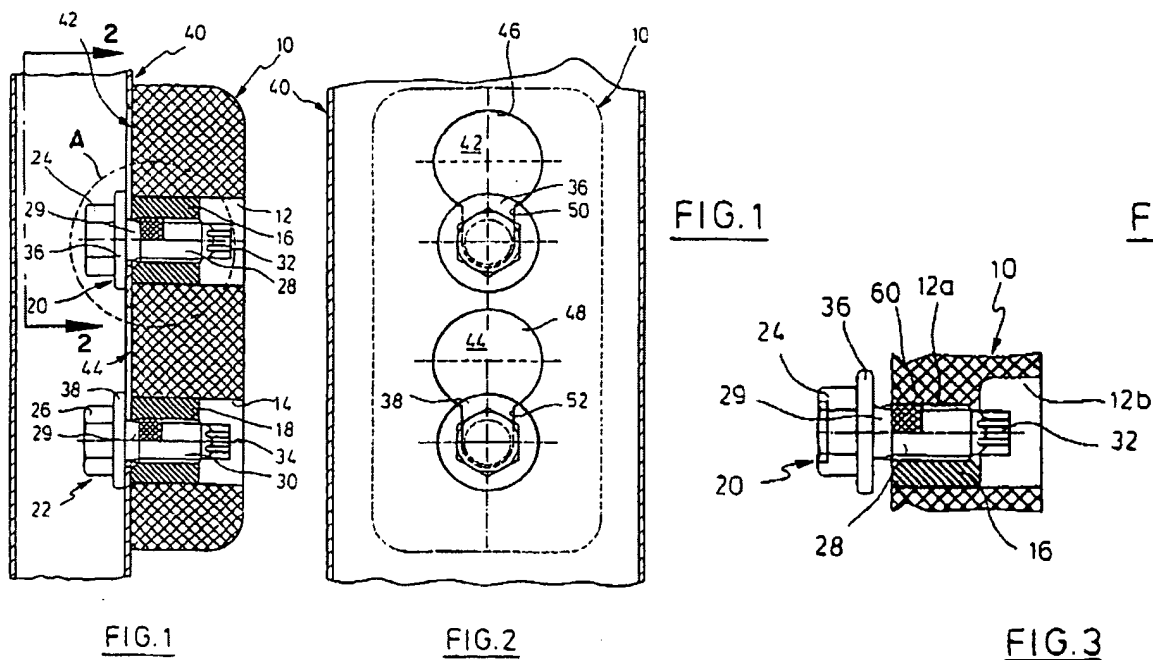
is opposite (directly across from is assumed) the shank, not "24". "36" is round and has a smooth surface.

Re claim 10: engagement surfaces are TORX® which is an external teething.

Re claim 11: Left hand thread is taught in Column 3 line 24-25.

Re claim 13: Self-locking bolt is taught in Column 3 lines 17-23 as a coated

shank is partially provided with a plastic coating 60 which allows the fastener 20 to remain in the pre-assembled 20 position. The coating 60 not only secures the pre-assembled state, but also locks the screw when finally tightened as shown in FIG. 1.



Re claim 14: It has been held that all threads are to some extent thread-forming for a corresponding bore, and thus would be for a corresponding bushing. As noted above, the thread and its coating are self-locking.

Re claim 17: The fasteners are described as threaded shanks in Column 2:

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Threaded fasteners 20, 22 are provided with a head 24, 26, threaded shanks 28, 30 and ends 32, 34. The threaded shank 28, 30 are threaded into the inner threads of the inserts 16, 18. The ends 32, 34 of the shanks 28, 30 each have a Torx-portion. The heads 24, 26 have integrally formed radial flanges 36, 38. A non-threaded portion 29 joins the heads 24, 26.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

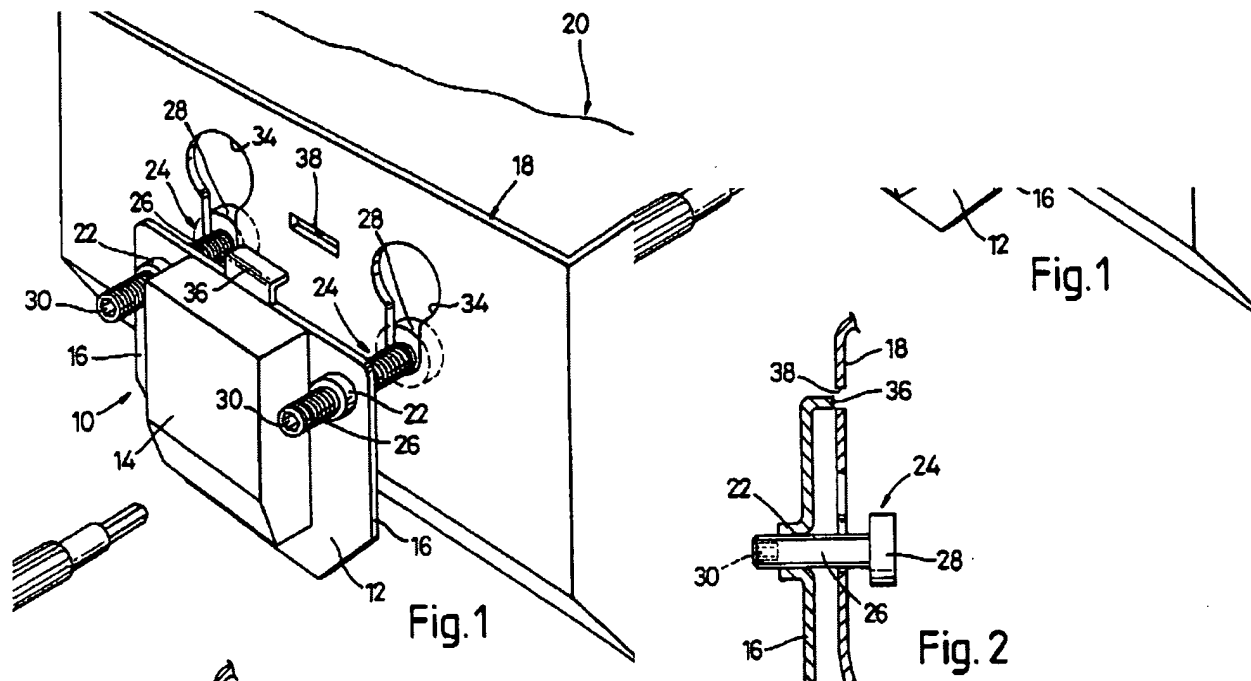
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al USP 6309132 in view of EP 0747604. As noted above, examiner was unable to obtain a copy of the document, but she did obtain a copy of the figures, and thus is applying the reference as best she can, rather than give no opinion until the entire document is submitted.

EP 604 teaches a similar fastener to that of Jakob, but includes mating parts 36,38 which serve to prevent both rotation and translation of the 1<sup>st</sup> component when assembled. Therefore, it would have been obvious to one of ordinary skill in the art, having the teachings of Jakob and EP 604 before him at the time the invention was made, to modify Jakob as taught by EP604 to include translational and rotational guards to prevent translation of the 1<sup>st</sup> component and rotation of the 1st component in order to obtain a secure and stable assembly. One would have been motivated to make such a combination because if the components were allowed translational and/or rotational

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movement, the heads could move to the larger hole of the keyhole and the assembly would come loose.



12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jakob et al USP 6309132 in view of Deblieux, United States Patent number 367196.

Jacob is silent on the fastening assembly as recited in claim 9, wherein the surface of the head to which the shank is attached includes tothing to prevent unscrewing. It is well known in the art to provide teeth to bite into a surface to prevent unscrewing, as, for example, explicitly taught by Deblieux, who teaches a nut, with teeth which are used to grip into the material in which the nut end surface presses against to prevent unscrewing, in Column 1:

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When the nut thus described is applied to a bolt and brought to bear upon the surface of the body to which the bolt is applied, the teeth *c* are brought into engagement with the surface, and when the nut is turned down upon the bolt so as to bring the portions of the rims *C* carried by the arms *b* intermediate between the ratchet teeth down firmly upon the surface, the combined pressure of all the arms will hold the work to which the nut is applied, while the ratchet-teeth will prevent the unscrewing of the nut.

Therefore, it would have been

obvious to one of ordinary skill in the art, having the teachings of Jacob and Deblieux before him at the time the invention was made, to modify Jacob as taught by Deblieux to include the gripping teeth of Deblieux, in order to obtain a fastener face that would bite into the surface against which it pressed to prevent unscrewing. One would have been motivated to make such a combination because a secure attachment would have been obtained, as taught/suggested by Deblieux in Column 1.

### ***Response to Arguments***

13. Applicant's arguments filed 10/29/2007 have been fully considered but they are not persuasive.

14. As noted above, Jacob teaches a self-locking fastener. Jacob has a head wherein the head's smooth surface is opposite the shank.

### ***Conclusion***

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine W. Mitchell whose telephone number is 571-272-7069. The examiner can normally be reached on Mon - Thurs 10 AM - 8 PM.

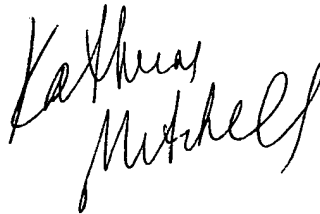
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 571-272-7087. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Katherine W Mitchell  
Primary Examiner  
Art Unit 3677

12/14/2007

A handwritten signature in black ink, reading "Katherine Mitchell". The signature is written in a cursive style with a large, stylized "K" and "M".